



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,437	11/22/2000	Paul Haeberli	11087-032001	2323

7590

02/19/2003

MARK D. KIRKLAND  
Fish & Richardson P.C.  
Suite 100  
2200 San Hill Road  
Menlo Park, CA 94025

EXAMINER

YANG, RYAN R

ART UNIT

PAPER NUMBER

2672

DATE MAILED: 02/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

MAR 05 2003

Technology Center 2600

**Office Action Summary**

Application No.

09/721,437

Applicant(s)

HAEBERLI ET AL. 

Examiner

Ryan R Yang

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-27 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-27 are pending in this application. Claims 1, 26 and 27 are independent claims. This action is non-final.
2. This application is a CIP of application number 09/684,595 filed 10/05/2000.
3. The present title of the invention is "Previewing and manipulating a framed image print".

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-11 and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-11, 12 and 16 of copending Application No. 09/721,437 in view of Oberg (5,870,771).

As per claim 1, the claim 1 of copending Application No. 09/721,437 has all the limitations except "providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the

frame in the perspective view", however, this is known in the art as taught by Oberg.

Oberg teaches in Figure 2A 36 "The digital image can be modified at 36 as the software allows the customer to crop the edges, delete unnecessary or undesirable portions of the image, or alter the image in some other way such as by changing colors or features, or combining the original image with portions from other digital image", column 6, line 1-6.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Oberg into the copending Application in order to create a special effect of the image.

6. Claims 2-11 are similarly rejected for they have the same limitations as claims 2-11 of copending application, respectively.

7. As per claim 26, the claim 12 of copending Application No. 09/721,437 has all the limitations except "providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view", however, this is known in the art as taught by Oberg. Oberg teaches in Figure 2A 36 "The digital image can be modified at 36 as the software allows the customer to crop the edges, delete unnecessary or undesirable portions of the image, or alter the image in some other way such as by changing colors or features, or combining the original image with portions from other digital image", column 6, line 1-6.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Oberg into the copending Application in order to create a special effect of the image.

8. Claim 27 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of copending Application No. 09/721,437 in view of Oberg (5,870,771), and further in view of Morris (6,453,361).

As per claim 27, the claim 16 of copending Application No. 09/721,437 has all the limitations except "providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view; and wherein the client computer includes client software embodied in a computer-readable medium, the client software comprising instructions operable to cause the client computer to upload the picture image to the server", however, this is known in the art as taught by Oberg and Morris. Oberg teaches in Figure 2A 36 "The digital image can be modified at 36 as the software allows the customer to crop the edges, delete unnecessary or undesirable portions of the image, or alter the image in some other way such as by changing colors or features, or combining the original image with portions from other digital image", column 6, line 1-6.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Oberg into the copending Application in order to create a special effect of the image.

Morris discloses a photo-service website in which the photo image can be uploaded to a photo-sharing website (column 1, line 28-29).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Morris into the copending Application and Oberg because the copending Application and Oberg disclose a method of generating a frame prototype image and Morris discloses the images can be uploaded to a server in order to be shared by multiple users.

9. This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Oberg (US 5,870,771).

As per claim 1, Oberg discloses a method of generating a frame prototype image showing a picture image framed within a frame, the method comprising:

providing a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame (Figure 3 62);

mapping the picture image to the picture portion of the frame image in order to generate the frame prototype image (Figure 3 64 “a computer display monitor 60 is shown with frame moulding 62 and matting material 64 superimposed on an input image 66”, column 7, line 34-36); and

providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view (Figure 2A 36 “The digital image can be modified at 36 as the software allows the customer to crop the edges, delete unnecessary or undesirable portions of the image, or alter the image in some other way such as by changing colors or features, or combining the original image with portions from other digital image”, column 6, line 1-6).

12. As per claim 2, Oberg demonstrated all the elements as applied to the rejected independent claim 1, supra, and further discloses identifying a picture portion of the frame image (Figure 3 66).

13. As per claim 3, Oberg demonstrated all the elements as applied to the rejected dependent claim 2, supra, and further discloses identifying the picture portion of the frame image includes providing a mat identifying the picture portion of the frame image (Figure 3 64).

14. As per claim 4, Oberg demonstrated all the elements as applied to the rejected dependent claim 3, supra, and further discloses the mat includes a plurality of pixels, each pixel having a pixel value (since the display device is a computer display, it is inherent that the image is represented by a plurality of pixels).

15. As per claim 5, Oberg demonstrated all the elements as applied to the rejected dependent claim 4, supra, and further discloses wherein identifying the picture portion of the frame image includes setting each pixel in the mat that corresponds to the picture portion of the frame image to a first pixel value ("The software associated with the present invention also allows the customer to adjust sizes and colors of the frame and matting material at 54", column 6, line 63-65).

16. As per claim 6, Oberg demonstrated all the elements as applied to the rejected dependent claim 2, supra, and further discloses wherein identifying the picture portion of the frame image includes identifying the outer perimeter of the picture portion of the frame image ("The widths of the matting along any size of the artwork is variable and selectable", column 6, line 43-44).

17. As per claim 7, Oberg demonstrated all the elements as applied to the rejected independent claim 1, supra, and further discloses wherein the picture portion of the frame image has a quadrilateral shape and the method further includes identifying the picture portion of the frame image including identifying the four corners of the picture portion ("The opening or openings can have any geometry shape such as rectangle, triangle, square, circle, and oval", column 6, line 40-41).

18. As per claim 8, Oberg demonstrated all the elements as applied to the rejected independent claim 1, supra, and further discloses displaying the frame prototype image (Figure 3 62).

19. As per claim 9, Oberg demonstrated all the elements as applied to the rejected independent claim 1, supra, and further discloses wherein mapping the picture image to



the picture portion of the frame image includes texture mapping the picture image to the picture portion of the frame image ("a data file may be used to provide input to the software programs and may contain information such as ... required by the software to generate output", column 5, line 40-46. Since the image is pre-stored, it is inherent that they are texture mapped).

20. As per claim 10, Oberg demonstrated all the elements as applied to the rejected independent claim 1, supra, and further discloses mapping the picture image to the picture portion of the frame image includes mapping the picture image to the picture portion of the frame image using the illumination of the picture portion of the frame image ((Figure 3 62 the frame moulding).

21. As per claim 11, Oberg demonstrated all the elements as applied to the rejected independent claim 1, supra, and further discloses the frame image is captured using a digital camera (Figure 3 70).

22. As per claim 12, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a cropping tool and the method includes

cropping the picture in accordance with user instruction (The digital image can be modified at 36 as the software allows the customer to crop the edges", column 6, line 1-3); and

presenting the cropped picture in the picture portion of the frame image (Figure 2B 52).

23. As per claim 13, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a border tool and the method includes

adjusting the border of the picture in accordance with user instructions ("allows the customer to adjust sizes and colors of the frame", column 6, line 64); and

presenting the picture including new border in the picture portion of the frame image (Figure 2C Create order template and output composite image of selection).

24. As per claim 14, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes an effects tool and the method includes

applying an effect to the picture in accordance with user instructions ("The digital image can then be modified at 36 ..., or alter the image in some other way such as changing colors or features, or combining the original image with portions from other digital images", column 6, line 1-6); and

presenting the picture including selected effect in the picture portion of the frame image (Figure 2B 52).

25. As per claim 15, Oberg demonstrated all the elements as applied to the rejection of claim 14, supra.

As for selecting the effect from the group consisting of black & white, soft focus, color tone and saturate, since these features are notoriously well known in the art in creating special effects image, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to incorporate these features in order to have a more expressive look of the image.

26. As per claim 16, Oberg demonstrated all the elements as applied to the rejection of claim 14, supra, and further discloses the effect applied is color tone and the method further comprises

receiving color tone adjustment data and presenting a color tone adjusted picture in the picture portion of the frame ("The digital image can then be modified at 36 ..., or alter the image in some other way such as changing colors or features", column 6, line 1-5).

27. As per claim 17, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes

a rotation tool and the method includes rotating the frame in accordance with user instructions ("Figure 4 illustrates this capability by showing a number of composite images 80 with different locations, orientations, and shapes of openings in the matting material", column 7, line 55-57. Thus, indicating rotating capability of the frame by the software controllable by the user); and

presenting the rotated framed in the framed image (Figure 4 illustrates this capability by showing a number of composite images 80 with different locations, orientations, and shapes of openings in the matting material", column 7, line 55-58).

28. As per claim 18, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a rotation tool and the method includes

rotating the picture image in the frame in accordance with user instructions ("Figure 4 illustrates this capability by showing a number of composite images 80 with different locations, orientations, and shapes of openings in the matting material", column 7, line 55-57. Thus, indicating rotating capability of the image in the frame by the software controllable by the user); and

presenting the rotated picture image in the frame of the framed image ("Figure 4 illustrates this capability by showing a number of composite images 80 with different locations, orientations, and shapes of openings in the matting material", column 7, line 55-58).

29. As per claim 19, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a border tool and the method includes receiving a border width selection ("The widths of the matting along any side of the artwork is variable and selectable", column 6, line 43-44, indicating the width information is received);

adjusting the border width of the picture image in accordance with the border width selection ("The widths of the matting along any side of the artwork is variable and selectable", column 6, line 43-44, indicating the width is adjusted); and

presenting the picture image including adjusted border in the framed image (Figure 2B 52).

30. As per claim 20, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a frame adjustment button and the method includes

receiving a frame size selection ("The widths of the matting along any side of the artwork is variable and selectable, and the framing projects can be of any size", column 6, line 43-45. Thus, indicating a frame size is selectable.);

changing a size of the frame in the perspective view in accordance with the frame size selection ("The widths of the matting along any side of the artwork is variable and selectable, and the framing projects can be of any size", column 6, line 43-45.);

mapping the picture image to a picture portion of the new size frame (Figure 2B 50); and

presenting the picture image in the framed image (Figure 2B 52).

31. As per claim 21, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a trimming tool and the method includes

trimming the picture image in accordance with user instructions (Figure 2A 36 "The digital image can then be modified at 36 as the software allows the customer to crop the edges, delete unnecessary or undesirable portions of the image", column 6, line 1-3); and

presenting the trimmed picture image in the frame of the framed image (Figure 2B 52).

32. As per claim 22, Oberg demonstrated all the elements as applied to the rejection of independent claim 1, supra, and further discloses the enhanced image set includes a delight me tool and the method includes

activating the delight me tool upon user request ("the system allows the customer to choose whether to have the system analyze the image at 38", column 6, line 8-9);

automatically selecting a feature or effect to apply to the framed image (Figure 2A 42 "the database 42 is an expert system that emulates store personnel who are trained in selecting coordinating combinations of frame moulding and matting material based on the color combination and subject matter of the artwork", column 6, line 5-18);

applying the selected feature to the framed image (Figure 2A 44); and

presenting the framed image (Figure 2A 52).

33. As per claim 24, Oberg demonstrated all the elements as applied to the rejection of claim 22, supra, and further discloses the step of automatically selecting a feature or effect includes selecting a feature or effect to apply to the picture image ("The software is also capable of analyzing the input image for color composition, determining dominant and secondary colors, and presenting combinations that complement the artwork", column 6, line 24-27).

34. As per claim 25, Oberg demonstrated all the elements as applied to the rejection of claim 1, supra, and further discloses the step of automatically selecting a feature or effect includes selecting a feature or effect to apply to the frame ("the software in the present invention allows him to search according to various input criteria such as types of materials for frame molding, matting material colors, cost, or whether he desires a ready-made frame or a custom-made frame", column 6, line 31-35).

35. As per claim 26, Oberg discloses a computer program product tangibly embodied in a computer-readable medium, for generating a frame prototype image showing a

picture image framed within a frame, comprising instructions operable to cause a computer to:

receive the picture image (Figure 3 72);

store a frame image showing the frame in a perspective view and a mat identifying the picture portion of the frame image (Figure 3 72);

map the picture image to the picture portion of the frame image in order to generate the frame prototype image (Figure 3 66); and

provide an enhanced edit set along with the frame prototype image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view (Figure 2A 36-44, Figure 2B 48-56).

***Claim Rejections - 35 USC § 103***

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (5,870,771) and further in view of Morris (6,453,361).

As per claim 27, Oberg discloses a system for generating a frame prototype image showing a picture image framed within a frame, the system comprising:

a client computer in communication with a computer network (Figure 3 70);

a server, in communication with a computer network, having server software embodied in a computer-readable medium, the server software comprising instructions operable to cause the server to:

- receive the picture image from the client computer (Figure 3 72);
- store a frame image showing the frame in a perspective view and a mat identifying the picture portion of the frame image (Figure 3 72);
- map the picture image to the picture portion of the frame image in order to generate the frame prototype image (Figure 2A 34); and
- present an enhanced edit set along with the frame prototype image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view (Figure 2A 36-44, Figure 2B 48-56); and

wherein the client computer includes client software embodied in a computer readable medium, the client software comprising instructions operable to cause the client computer to upload the picture image to the server (Figure 1 26).

Oberg discloses a method of generating a frame prototype image. It is noted that Oberg does not explicitly disclose the picture image can be uploaded to the server, however, this is known in the art as taught by Morris. Morris discloses a photo-service website in which the photo image can be uploaded to a photo-sharing website (column 1, line 28-29).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Morris into Oberg because Oberg



discloses a method of generating a frame prototype image and Morris discloses the images can be uploaded to a server in order to be shared by multiple users.

### ***Allowable Subject Matter***

38. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art by Oberg does not explicitly disclose the feature of randomly selecting a feature to be applied to a framed image in the method of generating a framed prototype image.

### ***Conclusion***

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

### ***Inquiries***

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ryan Yang** whose telephone number is **(703) 308-6133**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Razavi**, can be reached at **(703) 305-4713**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231


**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 305-47000377.

Ryan Yang  
January 30, 2003



**MICHAEL RAZAVI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**